

REMARKS

This amendment responds to the Office Action mailed May 16, 2003. In the Office Action, the Examiner objected to the drawings; objected to claims 1-15 and 21-23 for containing informalities; rejected claims 16-19 as being indefinite under 35 U.S.C. § 112, second paragraph; rejected claims 1-3, 5-10 and 15-17 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,810,823 to Klaue et al. ("Klaue"); rejected claim 4 under 35 U.S.C. § 103 as being unpatentable over Klaue; and rejected claims 11-14 and 18-23 under 35 U.S.C. § 103 as being unpatentable over Klaue in view of U.S. Patent No. 6,206,881 to Frigg et al. ("Frigg").

Claims 1-32, including new claims 24-32, will be pending as of entry of this amendment.

REMARKS CONCERNING THE DRAWINGS

The Examiner objected to the drawings under 37 C.F.R. 1.83(a) for failing to show (i) "the internal thread taper[ing] radially inwardly with respect to the central axis, as per claims 11, 18, and 20" and (ii) "the screw head ha[ving] an external thread taper at an angle substantially equal to the internal thread taper, as per claims 13 and 20." A proposed revision to Figure 1 is included in Appendix A.

In the proposed revision to Figure 1, slanted lines depicting external threads have been added to the screw-head 11. In addition, the inner surface of the hole in which screw-head 11 is located has been revised to show internal threading in cross-section. The outer periphery of the external threading on the screw-head 11 extends along the dashed-lines defining taper angle 15, as does the inner periphery of the internal threading of the hole in which screw-head 11 is located. No new matter has been added by these revisions to Figure 1, as these features are supported by the specification and claims as originally filed. (*See, e.g., Application As Filed at p. 2, ll. 16-21; p. 2, l. 34 - p. 3, l. 2; p. 4, ll. 24-30; p. 5, ll. 5-9.*) In addition, Applicants respectfully submit that Figure 1, as originally filed, depicts the internal thread tapering radially inwardly, as the hole 5 and the internal threads 7 formed thereon clearly extend along the dashed lines forming taper angle 13.

The Examiner is respectfully requested to approve the proposed drawing changes.

REMARKS CONCERNING CLAIM OBJECTIONS

The Examiner stated with respect to claim 1 that “surfaces” in line 4 should be changed to “surface.” Applicants have now amended claim 1 to recite “surface.” In addition, the claims have been amended throughout to recite a “lower surface” where they previously recited a “bone-contacting surface.” This amendment has been made, without prejudice, to broaden the claims and to clarify that the claims are not limited to plates that contact the bone. Rather, the lower surface of the plate may or may not contact the bone.

The Examiner objected to claim 21 as being in improper dependent form for referring to itself, and withdrew it and the claims depending therefrom (claims 22 and 23) from consideration. Claim 21 has been amended to clarify that it depends from independent claim 20. In addition, claim 22 has been amended to clarify that it depends from independent claim 20 as well. Consideration of claims 21-23 is now respectfully requested.

REMARKS CONCERNING CLAIM REJECTIONS

Claims 16-19 were rejected under 35 U.S.C. § 112, second paragraph. In particular, the Examiner pointed out that in claim 16, there is no antecedent basis for “the protrusion” in line 11. Claim 16 has been amended to the “protrusion” with the “tapered flange,” for which there is antecedent bases. Thus, Applicants respectfully request the rejection of claims 16-19 be withdrawn.

Claims 1-3, 5-10 and 15-17 were rejected under 35 U.S.C. § 102(b) as being anticipated by Klaue. Independent claim 1 has been amended to clarify that the “internal threads extend[] substantially from the upper surface to the lower surface” of the bone plate. Also, independent claim 16 has been amended to clarify that “the threaded holes hav[e] threads extending substantially from the upper surface to the lower surface” of the bone plate. Applicants respectfully submit that Klaue does not teach, disclose, or suggest threads that extend substantially from the upper surface to the lower surface of the bone plate. Rather, in each of the embodiments of a bone plate disclosed in Klaue, the threads terminate midway between the upper and lower surfaces (*i.e.*, well below the upper surface). Thus, Applicants respectfully submit that independent claims 1 and 16, and their dependent claims, are patentable over Klaue.

Claim 4 was rejected under 35 U.S.C. § 103(a) as being obvious over Klaue. Claim 4 depends from independent claim 1 which, as demonstrated above, is patentable over Klaue. Thus, claim 4 is patentable for at least the same reasons as claim 1.

Claims 11-14 and 18-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Klaue in view of Frigg. At the time the invention of the present application was made,

Frigg (which qualifies as prior art to this application only under 35 U.S.C. §102(e)) and this application were both owned by Synthes (U.S.A.). A copy of the assignment of the present invention to Synthes (U.S.A.) was recorded at the PTO on January 22, 2002 at Reel 12498, Frame 018. Thus, Applicants respectfully request the withdrawal of this application based on the combination of Klaue and Frigg. 35 U.S.C. § 103(c).

REMARKS CONCERNING NEW CLAIMS

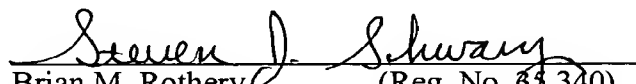
New claims 24-32 have been added to further define and broaden the scope of protection sought for the present invention. Applicants respectfully submit that new claims 24-32 define features that are not disclosed by the references of record, and accordingly, request allowance of same.

In light of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (202) 496-4475, if a telephone call could help resolve any remaining items.

A fee transmittal sheet is attached for the presentation of two additional independent claims and seven additional dependent claims. Should any other fees be required, please charge such fees to Pennie & Edmonds LLP deposit account no. 16-1150.

Respectfully submitted,

Date: August 13, 2003


By: Brian M. Rothery (Reg. No. 63,340)
Steven J. Schwarz (Reg. No. 47,070)
PENNIE & EDMONDS LLP
1667 K Street, N.W.
Washington, D.C. 20006
(202) 496-4400

Appendix A

Revised Figures (see attached copies)